



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/706,500

11/12/2003

David Tropp

7235

7590

02/02/2005

Steven Horowitz  
Counselor At Law  
Suite 700  
295 Madison Avenue  
New York, NY 10017

EXAMINER

LABAZE, EDWYN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/706,500

Applicant(s)

TROPP, DAVID

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12092004.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt is acknowledged of amendments filed on 12/09/2004.
2. Receipt is acknowledged of IDS filed on 12/09/2004.
3. Receipt is acknowledged of affidavit filed on 12/09/2004.
4. Claims 1-9 (including new claims 5-9) are presented for examination.

### ***Claim Objections***

5. Claims 1, 4, 8-9 are objected to because of the following informalities:

Re claims 1, 4, 8-9 (pages 2, 3, and 5; lines 6, 13, 3, and 19 respectively): The applicant discloses the limitation "any special lock of type". The language "this type" renders the limitations openly broad. The applicant is respectfully requested to substitute "any special lock of type" with "this special lock".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bretl et al. (U.S. 4,866,958).

Re claims 1 and 3-4: Bretl et al. discloses push-button lock mechanisms, which includes a combination lock portion (which includes a set of numbers as shown in fig. # 19-20) and having a master key lock portion 11 (col.9, lines 31+), the master key lock portion for receiving a master key 12 that can open the master key lock portion 11.

Bretl et al. fails to suggest that the special key designed to be applied to an individual piece of airline luggage and the luggage screening authority had agreed not to break, means of providing the luggage screening authority, directly or indirectly access to the master key.

The applicant did not disclose the TSA Approved requirements for a special lock so that the luggage screening authority has agreed not to break or clip the lock.

However, since the applicant discloses a special lock as having a combination lock portion and a master key lock (see page 3, last paragraph), an indicia thereon conveying to luggage purchasers that is approved by a luggage screening authority and agreed not to break. Therefore it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Bret et al. a special key designed to be applied to an individual piece of airline luggage. Furthermore, such modification would provide a means for securing an airline luggage (see U.S. reference 6,522,253 of Saltus). In addition, one would agree that the secret code for opening the lock should be personal (not available to luggage screening authority) so as to protect the personal contents within the luggage. Moreover, such modification would have been an obvious extension as taught by Bretl et al.

Re claim 2: Bretl et al. teaches an apparatus and method, wherein the master key lock portion includes a key hole 11 on a bottom of the special that receives the master key 12 (col.19, lines 19-60).

*Response to Arguments*

8. Applicant's arguments filed 12/09/2004 have been fully considered but they are not persuasive.

The applicant argues that the prior art of record, Bretl (U.S. 4,866,958) and Saltus (U.S. 6,522,253), do not address the problem of unlocked baggage and method of luggage inspection by a luggage screening entity that includes making available to consumers a special lock and an indicia matching an indicia previously provided to the luggage screening entity (see page 11, 2<sup>nd</sup> paragraph of applicant's arguments).

The examiner respectfully disagrees with the applicant's remarks for the following reasons:

Re claims 1, 4, and 8-9: The applicant discloses the limitations "the special lock also having an indicia associated therewith that matches an indicia previously provided to the luggage screening entity, which special lock the luggage screening entity has agreed to process in accordance with a special procedure"; "marketing the special lock to the consumers in a manner that conveys to the consumers that the special lock will be subjected by the luggage screening entity to the special procedure" and "the luggage screening entity acting pursuant to a prior agreement to look for the indicia while screening luggage and upon finding said indicia on an individual piece of luggage, to use the master key previously provided to the luggage screening entity to if necessary, open the individual piece of luggage". These limitations carry no patentable for the following reasons:

- The indicia on the lock is a printed matter as herein considered is not determined by its physical form but by the fact it conveys information, there being no new feature of the

Art Unit: 2876

physical structure such limitations may not be allowed. It is only where the limitations define either new features of structure or new relations of printed matter of the structure (In Re Gwinn, 112 USPQ 439).

- Marketing a special lock is a step of selling of the product
- The applicant discloses the limitations “a special lock”, which the luggage screening entity has agreed to process in accordance with a special procedure. This limitation is not patentable because the special lock is not structurally different from the master lock as taught by teachings of the prior art and the special procedure is an agreement and could be broadly interpreted as a warning to the consumers {when purchasing the special lock} that the lock will not break {by clipping the lock} when the luggage is subjected to inspection but a master key of the lock is provided to the luggage screening entity for opening the lock.

Re claim 2: The applicant discloses the limitations “wherein the master key lock portion includes a key hole on a bottom of the special lock that receives the master key”. This is well known in the art (see reference U.S. 4,838,052 of Williams et al.).

Re claims 3 and 6: The applicant discloses the limitations “wherein a step of making available to consumers a special lock involves mass producing the special lock and selling the special lock to the consumers”. This limitation is an obvious step in order to sell the product.

Re claims 5 and 7: The applicant discloses the limitations “wherein the indicia is located directly on the special lock”. This limitation is a printed matter and does not further differentiate and/or define the structure of the lock, neither the use of the lock. Therefore, such limitation does not carry any patentable weight.

Art Unit: 2876

Therefore the examiner retains the rejection as set forth in the outstanding office action (paper No. 9162004).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Williams et al. (U.S. 4,838,052) discloses lock system.

Ling (U.S. 5,737,947) teaches mother-and-daughter combination lock.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
January 10, 2005



**THIEN M. LE**  
**PRIMARY EXAMINER**